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REMARKS

Claims 1-18 are pending. Claim 14 has been amended to correct a typographical error.

Claims 1-14

Claim 1 stands rejected under § 103(a) as being unpatentable over U.S. Patent No. 5,877,758 to Boden et al. ("Boden"), U.S. Patent No. 5,877,758 to Seybold ("Seybold"), U.S. Patent No. 5,918,014 to Robinson ("Robinson"), and U.S. Patent No. 6,094,649 to Bowen et al. ("Bowen"). However, it is submitted that this combination of references is improper for the following reasons.

According to MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Office action states that "Boden, Seybold, Robinson, and Bowen teach the use of computers, the use of networks, the viewing and updating of data, the use of information, the use of users of the system, and the use of applications and Boden, Seybold, Robinson, and Bowen teach the use of logging on. It is clear, that the references of Boden, Seybold, Robinson, and Bowen use similar technologies." (Office action, p. 23, para. 29).

The Applicant respectfully submits that the preceding paragraph fails to meet the legal requirement embodied in MPEP § 2143.01, because the cited prior art combination fails to "suggest[] the desirability of the combination." In fact, if the above references are properly combinable simply because they use "similar technologies," which the Office action seems to imply, then it is difficult to imagine a combination of computer-related references that could not be asserted against Applicant's application.

While Applicant agrees that each reference teaches the use of computers (as do literally thousands of patents), the references use the computers to address problems in different computer fields. For example, Boden is directed to an apparatus and method for process modeling using both a web server and a workflow server in process definition. (See

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Abstract). "During buildtime, a process definition in the language of some workflow process modeler is fed to transform $f(p)$, which provides a translate process definition into a hypertext markup language (HTML) representation of the workflow process. A user utilizing the facilities of an HTTP server may operate a web browser to request that HTTP server provide the HTML process definition to enable the user to create, or read and modify, the process definition as desired. The result is then fed through an inverse transform $f(p)$ to a workflow server in the language of that server, for invocation and execution during runtime of the programs defined during buildtime." (Abstract).

Seybold is directed to "[a] control device for adjusting multiple parameters associated with an element or item of a user interface in an easy and intuitive manner." (Abstract). "A slider control can be used to change the format or appearance of a timescale presented by the user interface. By using a single visual interface control, a slider control, a time-based scaling of a given view can be easily switched between predefined timescale settings for the timescale." (Abstract).

Robinson is directed to automated collaborative filtering in world wide web advertising. More specifically, Robinson "combines techniques for: determining the subject's community, and determining which ads to show based on characteristics of the subject's community. The information used to determine whether a given individual should be in the subject's community is gleaned from the individual's activities in the interactive medium." (Abstract).

Bowen is directed to "[m]ethods and systems ... for supporting keyword searches of data items in a structured database, such as a relational database. Selected data items are retrieved using an SQL query or other mechanism." (Abstract).

The case law forbids this type of combination by requiring that there must be evidence that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. It is also clear that a rejection cannot be predicated on the mere identification of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Ecologchem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1076 (Fed. Cir. 2000). Applicant respectfully submits that no such findings have been presented in the Office action to support the combination of references. There is absolutely no finding as to

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why Boden's method for process modeling using both a web server and a workflow server in process definition would be properly combined with Seybold's control device for adjusting multiple parameters associated with an element or item of a user interface in an easy and intuitive manner, Robinson's automated collaborative filtering in world wide web advertising, or Bowen's keyword searches of data items in a structured database.

In response to a similar argument made previously by Applicant, the Office action states that "[I]n response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references." (Office action, p. 23, para. 30). Applicant respectfully submits that Applicant is not attacking the references individually, but rather briefly describing each reference to emphasize why each reference is not properly combinable with the other references. As such, Applicant's argument is addressing each reference as part of a larger argument that the references are not properly combinable. The above language of *Ecolochem* requiring particular findings is clearly directed to what constitutes an improper combination.

Furthermore, Applicant respectfully submits that the Office action simply takes bits and pieces of information from each reference and pieces them together like a jigsaw puzzle using the Applicant's disclosure as a blueprint. However, the case law makes it clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. See *Dembiczak*, 50 USPQ2d, 1614, 1617 (Fed. Cir. 1999). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight." *Id.* It is respectfully submitted that the only way the cited references could be pieced together to defeat patentability is indeed to use Applicant's disclosure as a blueprint.

In response to a similar argument made previously by Applicant, the Office action states that "it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper." (Office action, p. 24, para. 31). Applicant respectfully submits that this fails to address Applicant's argument that the Examiner's failure

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to render a showing of a teaching or motivation to combine the prior art references is the essence of hindsight, as recited in *Dembiczak*.

Accordingly, it is respectfully submitted that claim 1 is allowable over the cited references for at least the reasons stated above. Claims 2-14 depend from and further limit claim 1 and therefore are allowable for at least the same reasons as claim 1.

Claims 15-18

Claim 15 stands rejected under § 103(a) as being unpatentable over U.S. Patent No. 6,182,080 to Clements ("Clements"), U.S. Patent No. 6,253,234 to Hunt et al. ("Hunt"), Boden, and Robinson. However, it is submitted that this combination of references is improper for the following reasons.

As stated previously, according to MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Similarly to the rejection of claim 1, the Office action states that "the Clements, Hunt, Boden, and Robinson references come from related technologies. Clements, Hunt, Boden, and Robinson teach the use of computers, the use of databases, the use of networks, the updating of data, the use of information, the use of users of the system, and the use of applications and Clements, Boden, and Robinson teach the viewing of data, the use of categories, and the use of documents. It is clear, that the Clements, Hunt, Boden, and Robinson references use similar technologies." (Office action, p. 23, para. 29).

The Applicant respectfully submits that the preceding paragraph fails to meet the legal requirement embodied in MPEP § 2143.01, because the cited prior art combination fails to "suggest[] the desirability of the combination." In fact, if the above references are properly combinable simply because they use "similar technologies," which the Office action seems to imply, then it is difficult to imagine a combination of computer-related references that could not be asserted against Applicant's application.

While Applicant agrees that each reference teaches the use of computers (as do literally thousands of patents), the references use the computers to address problems in

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different computer fields. For example, Clements is directed to the storage of multiple documents and a tracking log within a single file. (Abstract). "More specifically, the present invention provides a convenient way to organize multiple documents and store them within a single file in a manner that facilitates exchange of the collection of documents and collaboration on the collection by a group of individuals." (Abstract).

Hunt is directed to shared web page caching at browsers for an intranet. More specifically, "[e]ach client in an intranet includes at least the minimum functionality required to serve a remote request such as an HTTP request. Existing browsers within the intranet may share their collective local caches to form a scalable cache. The intranet proxy routes page requests from one client within the intranet to another when a local cache within the intranet contains a current copy of the requested page. A trust protocol insures that clients serving as caches may be trusted by the proxy, while a refresh mechanism such as a time-out policy ensures that the page is reloaded after a predetermined period of time." (Abstract).

As stated previously in greater detail, Boden is directed to an apparatus and method for process modeling using both a web server and a workflow server in process definition, and Robinson is directed to automated collaborative filtering in world wide web advertising.

The case law forbids this type of combination by requiring that there must be evidence that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. It is also clear that a rejection cannot be predicated on the mere identification of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Ecolochem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1076 (Fed. Cir. 2000). Applicant respectfully submits that no such findings have been presented in the Office action to support the combination of references. There is absolutely no finding as to why Clements' storage of multiple documents and a tracking log within a single file would be properly combined with Hunt's shared web page caching at browsers for an intranet, Boden's method for process modeling using both a web server and a workflow server in process definition, or Robinson's automated collaborative filtering in world wide web advertising.

In response to a similar argument made previously by Applicant, the Office action states that "[I]n response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are

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based on combinations of references." (Office action, p. 27, para. 36). Applicant respectfully submits that Applicant is not attacking the references individually, but rather briefly describing each reference to emphasize why each reference is not properly combinable with the other references. As such, Applicant's argument is addressing each reference as part of a larger argument that the references are not properly combinable. The above language of *Ecolochem* requiring particular findings is clearly directed to what constitutes an improper combination.

Furthermore, Applicant respectfully submits that the Office action simply takes bits and pieces of information from each reference and pieces them together like a jigsaw puzzle using the Applicant's disclosure as a blueprint. However, the case law makes it clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. See *Dembiczak*, 50 USPQ2d, 1614, 1617 (Fed. Cir. 1999). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight." *Id.* It is respectfully submitted that the only way the cited references could be pieced together to defeat patentability is indeed to use Applicant's disclosure as a blueprint.

In response to a similar argument made previously by Applicant, the Office action states that "it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper." (Office action, p. 27, para. 37). Applicant respectfully submits that this fails to address Applicant's argument that the Examiner's failure to render a showing of a teaching or motivation to combine the prior art references is the essence of hindsight, as recited in *Dembiczak*.

Accordingly, it is respectfully submitted that claim 15 is allowable over the cited references for at least the reasons stated above. Claims 16-18 depend from and further limit claim 15 and therefore are allowable for at least the same reasons as claim 15.

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Conclusion

Therefore, it is respectfully submitted that independent claims 1 and 15 are in condition for allowance. Dependent claims 2-14 and 16-18 depend from and further limit independent claims 1 and 15 and therefore are allowable as well.

Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.

Respectfully submitted,

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